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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,618	08/13/2002	Ulrich Peuchert	2088	5526

7590 12/22/2003  
Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8FB

**Office Action Summary**

Application No.

10/088,618

Applicant(s)

PEUCHERT ET AL.

Examiner

Elizabeth A. Bolden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because the abstract is more than one paragraph in length. Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

Claim 6 is objected to because of the following informalities:

Claim 6 states two ranges for the coefficient of thermal expansion of the glass, the Examiner is giving the broadest meaning to the claim at a range of  $>5$  to  $6.0 \times 10^{-6}/K$ . Furthermore, the Examiner would like to point out for the record that  $>5$  is essentially 5 and the claim will be examined as of having a range of 5 to  $6.0 \times 10^{-6}/K$ . If the applicant's wish to claim the narrowed ranges the additional ranges should be in separate dependent claims. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-9 provide for the use of a borosilicate glass, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

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intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kiefer, U.S. Patent 4,870,034.

Kiefer discloses a borosilicate glass having overlapping ranges of components with instant claims 1-5. See abstract and column 2, lines 40-47. Kiefer discloses a glass having overlapping ranges of thermal expansion coefficient and working point temperatures with instant

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claim 6. See column 2, lines 34-38. The compositional ranges and property ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations and property limitations in claims 1-6. See MPEP 2131.01. Furthermore, Kiefer discloses Examples 1-3 and 5, which meets all the limitations of claims 1-5, and Example 6, which meets all the limitations of claims 1-6. See Table 2. Kiefer discloses in Table 1, Examples 2 and 3, which meet all the limitations of claims 1, 2, and 4, and Example 4, which meets all the limitations of claims 1-6.

Kiefer discloses that the glass is used for laboratory glass, pharmaceutical containers, lamp glass, and X-ray tube glass suitable for sealing with Fe-Co-Ni alloys. See abstract, column 1, lines 30-33, and column 2, lines 5-7.

Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moser, U.S. Patent 4,386,164.

Moser discloses a borosilicate glass having overlapping ranges of components with instant claims 1-5. See abstract and column 2, lines 40-47. Moser discloses a glass having an overlapping range of thermal expansion coefficient with instant claim 6. See column 2, lines 54-56. The compositional ranges and thermal expansion coefficient ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations and thermal expansion coefficient limitations in claims 1-6. See MPEP 2131.01. Furthermore, Moser discloses examples including ASTM E 438-80a Standard Glass, which meets all the limitations of claims 1-6. See column 2, lines 25-45 and Table I.

Moser discloses that the glass is used for laboratory glass and pharmaceutical containers. See column 1, lines 5-11 and 41-49, and column 2, lines 5-7.

Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kosokabe et al., Japanese Patent Publication 08-333136.

A machine-generated translation of JP 08-333136 accompanies this action. In reciting this rejection, the examiner will cite this translation.

Kosokabe et al. disclose a borosilicate glass having overlapping ranges of components with instant claims 1 and 3-5. See Abstract and paragraph [0009]. Kosokabe et al. disclose a glass having an overlapping range of thermal expansion coefficient with instant claim 6. See paragraph [0009]. The compositional ranges and thermal expansion coefficient ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations and thermal expansion coefficient limitations in claims 1 and 3-6. See MPEP 2131.01. Furthermore, Kosokabe et al. disclose Example 5, which meets all the limitations of claims 1 and 4. See Table 1.

Kosokabe et al. disclose that the glass is used for sealing Fe-Co-Ni alloys. See paragraphs [0001] and [0010].

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Kosokabe et al. would inherently possess the same working temperature as recited in claim 6. See MPEP 2112.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Walther et al., German Patent Publication DE 198 01 861 A1.

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This rejection is over the German Patent DE 198 01 861 A1 because this reference qualifies as prior art under 35 U.S.C. 102(b). However, for convenience, the column and line numbers of the English language equivalent US Patent No. 6,200,658 will be cited below.

Walther et al. disclose Examples 7, 8, and 12-14, which meets all the limitations of claims 1-4, and Examples 11 and 12, which meets all the limitations of claims 1, 2, 4, and 5. See Table 1.

Walther et al. disclose that the glass is used for chemical plants structures, laboratory apparatuses, medicinal ampoules, sheathing material, and lamps. See column 1, lines 28-43.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Walther et al. would inherently possess the same thermal expansion coefficient and working temperature as recited in claim 6. See MPEP 2112.

Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Daimon, Japanese Patent Publication 04-074731.

The Derwent Abstract 1992-129199 accompanies this action. In reciting this rejection, the examiner will cite the Abstract.

Daimon discloses a borosilicate glass having overlapping ranges of components with instant claims 1-5. See Derwent Abstract. Daimon discloses a glass having an overlapping range of thermal expansion coefficient with instant claim 6. See Derwent Abstract. The compositional ranges and thermal expansion coefficient ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations and thermal expansion coefficient limitations in claims 1-6. See MPEP 2131.01. Furthermore, Daimon discloses Examples 5 and

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6, which meets all the limitations of claims 1-6 and Examples 1-4, which meets all the limitations of claims 1-5. See Table on page 3 of the Japanese Patent Publication.

Daimon discloses that the glass is used for laboratory purposes and ampoules. See Derwent Abstract.

### *Conclusion*

The additional references cited on the 892 and 1449 have been cited as art of interest since they are considered to be cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 9:30 am-7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

After the move to the new USPTO headquarters in Alexandria, Virginia, tentatively scheduled for the week of December 22, 2003, the examiner's new phone number will be (571) 272-1363 and Mark Bell's new phone number will be (571) 272-1362.

EAB  
03 December 2003

  
**DAVID SAMPLE**  
**PRIMARY EXAMINER**